## ***Remarks***

Upon entry of the amendment, claims 1-73 will be pending. New claims 24-73 have been added. Support for the newly added claims is found throughout the specification as filed. Specifically, support for new claims 24-73 may be found at, for example, Table 1 at page 72, row 2, as indicated as "Gene No. 23;" page 88, line 29 to page 90, line 16 (for signal sequences); page 91, line 8 to page 92, line 8 and page 93, line 7 to page 94, line 1 and page 99, line 26 to page 100, line 16 and page 103, lines 11-24 (for polypeptide variants); page 101, lines 13-28 (for ELISA and Western blot); page 108, lines 3-28 (for antibodies); page 110, lines 10-16 and page 142, line 19 to page 144, line 2 and page 168, line 29 to page 170, line 12 (for antibody diagnostics); page 147, line 5 to page 148, line 30 (for heterologous); Examples 5-8 beginning on page 287 (for methods of isolating expressed polypeptide). Thus, no new matter has been introduced.

Applicants note that the present claimed invention is specifically and highly expressed in human adrenal gland tumor tissue (*see* page 58, lines 18 of the specification). Therefore, the present claimed invention is useful for the diagnosis of adrenal gland tumors (*see* page 58, lines 19-22 and page 59, lines 7-8 of the specification).

### ***The Restriction Requirement***

On page 2 of Paper No. 8, the Examiner has separated the claimed invention into ten (10) Inventions. The Examiner contends that the inventions are independent and/or distinct, each from the other, and thus, has required an election under 35 U.S.C. § 121.

In order to be fully responsive, Applicants hereby provisionally elect, *with traverse*, Group II, encompassing claims 11-12 and 16 and newly added claims 24 to 73, drawn to purified polypeptides of SEQ ID NO:73 and clone ID HATCM08, for further prosecution.

With respect to the Examiner's division of the invention into ten (10) Inventions and the reasons stated therefor, Applicants respectfully traverse for the reasons stated below. In the event that the Examiner makes said restriction final, Applicants respectfully reserve the right to petition the restriction requirement under 37 C.F.R. § 1.144.

Applicants submit that even where two patentably distinct inventions appear in a single application, restriction remains improper *unless* it can be shown that the search and examination of both inventions would entail a "serious burden" (*See* M.P.E.P. § 803). In the present situation, no such showing has been made, at least with respect to Inventions III and VI, wherein the Examiner has assigned the same classification to both, class 514, subclass 2.

Under MPEP §803, a prima facie showing of a serious search burden is made when separate classification is demonstrated. This was not shown for the above mentioned Inventions.

Even assuming, *arguendo,* that Inventions I-X represent distinct inventions, Applicants disagree with the Examiner's assertions on pages 5-6 of Paper No. 8 that to search and examine the subject matter of all the Inventions together would not be a serious burden on the Examiner. Applicants submit that a search of polynucleotide claims of the invention would provide useful information for examining claims directed to both polynucleotides and the polypeptides encoded by these polynucleotides. In certain claims this is especially true because the polynucleotide sequence of these claims is defined in part by the polypeptide that the polynucleotide sequence encodes. Further, Applicants point out that, in many if not most publications, where a published nucleotide sequence is an open reading frame, the authors also include, as a matter of routine, the deduced amino acid sequence of the encoded polypeptide.

Similarly, a search of the polypeptide claims of the invention would clearly provide useful information for the examination of claims directed to antibodies either produced in response to or having affinity for the subject polypeptides. This is because antibodies are frequently defined by the antigens that they are produced in response to and the epitopes to which they bind. Moreover, in many publications where an antibody is described, the antigen that it was produced in response to is also described.

Further, searches of publications directed to polynucleotides and the use of those polynucleotides would clearly be overlapping. This is so because in many, if not most, publications which describe polynucleotides, these molecules are described by their function, characterization and/or expression profile. Thus, a search of polynucleotide claims would also provide the Examiner with art directed to the manner in which the claimed polynucleotides could be used in diagnostic and therapeutic indications.

Further, searches of publications directed to polypeptides and the use of those polypeptides would clearly be overlapping. This is so because in many, if not most, publications which describe polypeptides, these molecules are described by their function. Thus, a search of polypeptide claims would also provide the Examiner with art directed to the manner in which the claimed polypeptides could be used to treat disease states.

In view of the above, Applicants submit that the searches for polynucleotides, polypeptides, and antibodies; as well as methods of diagnosing, preventing and treating disease states using the nucleic acids and proteins of the subject invention; and methods of identifying a binding partner to a polypeptide of the subject invention; and methods of

identifying an activity in a biological assay of the subject invention; and the translational products produced by the methods of identifying an activity in a biological assay wherein said translational products have said activity would clearly be overlapping. Accordingly, Applicants request that, in view of M.P.E.P. § 803, the claims of all of Inventions I to X should be searched and examined in the subject application and particularly with respect to Inventions III and VI for the reasons stated above.

Accordingly, Applicants respectfully request that the restriction requirement under 35 U.S.C § 121 be reconsidered and withdrawn and the instant claims be examined in one application.

Applicants retain the right to petition from the restriction requirement under 37 C.F.R. § 1.144 should it be made final.

***Conclusion***

If there are any fees due in connection with the filing of this paper, please charge the fees to our Deposit Account No. 08-3425. If a fee is required for an extension of time under 37 C.F.R. § 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,

Date: March 28, 2002

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